

### **REMARKS**

Claims 1-2, 5, 7-13, 15-22, 24-25, 28, 30-36, 38, and 41-59 are currently pending in this application. By virtue of this amendment, claims 1, 2, 15, 24, 25, and 38 have been amended and claims 14, 23, and 37 have been cancelled. New claims 58-59 have been added to further define the soluble aluminum salt contained in the composition of the invention. Support for these new claims can be found in the specification, at page 4, lines 11-17. Reconsideration and allowance of the above referenced patent application in view of the amendments made above and the remarks to follow is respectfully requested.

Applicant notes with appreciation the indication by Examiner that claims 44-57 are allowable over the prior art of record and that claims 15 and 38 stand objected to as being dependent on rejected base claims, but would be allowable if rewritten in independent form.

Claims 1 and 24 describe a conversion coating composition and a method of forming a conversion layer on a surface using the aqueous conversion coating composition. These claims have been amended to recite that the aqueous conversion coating composition consists essentially of:

(a) a source of tungstate ions, wherein said source of tungstate ions is selected from the group consisting of ortho-tungstates, meta-tungstates and para-tungstates, polytungstates, heteropolytungstates, isopolytungstates, peroxytungstates, and combinations thereof;

(b) a soluble material comprising zirconium;

(c) optionally, a neutralization agent;

(d) optionally, a soluble aluminum salt; and

(e) optionally, one or more ingredients selected from the group consisting of surfactants, accelerators, dyes, organic polymers, buffering agents, and pH adjusting agents.

Applicants respectfully submit that none of the prior art, alone or in combination describe or suggest conversion coating compositions that consist essentially of the ingredients of Applicants' claimed composition.

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original). See also *Atlas Powder v. E.I. duPont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *In re Janakirama-Rao*, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); *Water Technologies Corp. vs. Calco, Ltd.*, 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988).

#### **Claim Rejections Under 35 U.S.C. §102**

Claims 24-25, 28, 33, and 42-43 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Kresge et al.

As discussed above, Applicants have amended claim 24 to specify a composition that consists essentially of a source of tungstate ions, a soluble material comprising zirconium, optionally, a neutralization agent, optionally, a soluble aluminum salt; and optionally, one or more ingredients selected from the group consisting of surfactants, accelerators, dyes, organic polymers, buffering agents, and pH adjusting agents.

Applicants respectfully submit that Kresge et al. do not describe or suggest all of the elements of Applicants' claimed invention. Kresge et al. teach a composition that is used to produce a dried catalyst, not an aqueous conversion coating composition. As set forth in Example 4, the components of Kresge et al., while dissolved in water, do not produce an aqueous composition. Furthermore, Kresge et al. do not describe or suggest a composition consisting essentially of the ingredients of Applicants' claimed invention.

The compositions described by Kresge et al. require an iron or manganese component in order to produce the catalysts of their invention. Applicants respectfully submit that the presence of the iron or manganese component in the compositions described by Kresge et al. produces a materially different product than the compositions described and claimed by Applicants. Therefore, Kresge et al. do not teach or suggest all of the elements of Applicants' claimed invention.

**Claim Rejections Under 35 U.S.C. §103**

Claims 1-2, 5, 7-14, 16-19, 21-25, 28, 30-36, and 41-43 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Wada et al. In addition, claims 1-2, 5, 7-14, 16-24, 28, 30-37, and 41-43 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Dolan.

As discussed above, Applicants have amended independent claims 1 and 24 to specify a composition consisting essentially of a source of tungstate ions, a soluble material comprising zirconium, optionally, a neutralization agent, optionally, a soluble aluminum salt; and optionally, one or more ingredients selected from the group consisting of surfactants, accelerators, dyes, organic polymers, buffering agents, and pH adjusting agents.

In contrast, Wada et al. describes a composition that contains titanium and phosphate ions as essential elements of their composition (see e.g., column 2, lines 53-61 and column 3, lines 40-45), which are not required or even suggested by Applicants' claimed invention. Applicants respectfully submit that the compositions of Wada et al. do not meet all of the limitations of Applicants' claimed invention because titanium and phosphorus are essential elements of these compositions. Furthermore, the presence of titanium and phosphorus in the compositions of Wada et al. produces a materially different conversion coating composition than the compositions described and claimed by Applicants. Thus, Wada et al. do not anticipate or render obvious all of the elements of Applicants' claimed invention.

Dolan does not cure the deficiencies of Wada et al. because Dolan also does not describe or suggest a conversion coating composition consisting essentially of only the elements of Applicants' claimed invention. Applicants respectfully submit that the compositions of Dolan do not meet all of the limitations of Applicants' claimed invention because the presence of phosphorus-containing inorganic oxyanions or phosphonate ions is a required elements of the compositions. Furthermore, the presence of oxyanions or ions in the compositions of Dolan produce a materially different conversion coating composition that the compositions described and claimed by Applicants. Thus, Dolan does not anticipate or render obvious all of the elements of Applicants' claimed invention.

Applicant respectfully submits that none of the prior art, alone or in combination, teach all of the elements of Applicant's claimed invention. Reconsideration and withdrawal of the rejection of claims 1-2, 5, 7-14, 16-19, 21-25, 28, 30-36, and 41-43 as being unpatentable over Wada et al. and of claims 1-2, 5, 7-14, 16-24, 28, 30-37, and 41-43 as being unpatentable over Dolan is respectfully requested.

### **CONCLUSION**

Applicants believe that the foregoing is a full and complete response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejection of the claims is requested. Applicants believe that claims 1-2, 5, 7-13, 15-22, 24-25, 28, 30-36, 38, and 41-59 are now in condition for allowance and an indication of allowability and an early Notice of Allowance of all of the claims is respectfully requested.

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If Examiner feels that a telephonic interview would be helpful, he is requested to call the undersigned at (203) 575-2648.

Respectfully submitted,



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